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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID GAST and STEVEN B. ELGEE

Appeal 2009-005366
Application 10/829,438
Technology Center 2800

Before KENNETH W. HAIRSTON, CARLA M. KRIVAK, and
WILLIAM B. BAUMEISTER, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-16, 18-23, and 25-27. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants' claimed invention is an imaging device that reduces the amount of user interaction necessary to configure imaging parameters with settings related to the type of media selected by the user (Spec. ¶ [0016]). Patterns are formed on the sides of sheets in a media stack to, for example, encode imaging data for configuring an imaging device, identify the type of media in the media stack or imaging parameter settings, or identify the number of sheets expected to be found in the media stack (Spec. ¶¶ [0017], [0018]).

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

1. An apparatus, comprising:

a tray for holding a media stack, the media stack having opposing faces joined by sides, a pattern being formed on at least one of the sides, each face being a face of a media sheet, the pattern including a plurality of sub-patterns, each sub-pattern being formed on a different subset of sheets in the media stack and encoding imaging data or a reference associated with the imaging data for the subset of sheets on which the sub-pattern is formed, the imaging data for at least one subset of sheets identifying an expected number of sheets in that subset; a sensor;

a transport mechanism to move the tray past the sensor to scan the sub-patterns; and

control logic operable to communicate with the sensor to decipher the imaging data from the sub-patterns for each subset of sheets in the media stack.

REFERENCES

Faith	US 3,679,876	Jul. 25, 1972
Biegelsen	US 6,335,084 B1	Jan. 1, 2002

The Examiner rejected claims 1, 2, 6, 8, 9, 11, and 18 under 35 U.S.C. § 102(b) based upon the teachings of Faith.

The Examiner rejected claims 3-7, 9, 10, 12-16, 19-23, and 25-27 under 35 U.S.C. § 103(a) based upon the teachings of Biegelsen and Faith.

Appellants contend Faith does not teach a sub-pattern formed on a subset of cards and pulses on Faith's cards have nothing to do with configuring/encoding imaging data or a reference associated with the imaging data of a particular subset of sheets (App. Br. 12; Reply Br. 4).

ANALYSIS

The Examiner finds the recited "pattern" in Appellants' claims is intended use and thus, no weight has been given this term (Ans. 13). We disagree. As Appellants assert, claim 1 recites the control logic communicates with a sensor to "decipher 'imaging data' from the sub-patterns" for each subset of sheets (Reply Br. 3). Thus, the term "pattern" is not intended use and will be considered.

The Examiner also finds Faith "teaches a pattern sensed by a sensor, where the sensor communicates with a control unit, then the control unit deciphers the data within the subset of cards" (Ans. 13). Further the Examiner finds Faith teaches cards defined as subsets, such as cards 1-5 as a first group (first subset), cards 6-10 as a second group (second subset), etc. Therefore, each subset has a plurality of sub-patterns (magnetic pulses) containing coded information that make up an overall pattern (Ans. 13).

Faith teaches a deck of punch cards used to program a computer (col. 1, ll. 6-10). Each card has a magnetic stripe along its edge where a unique pulse combination is recorded (col. 1, ll. 61-68). The pulse combination on each card identifies the position of the card within the deck (col. 1, ll. 67-70). Because Faith's magnetic stripe encodes a position of the card within the deck, the pulses only decipher the position of the card within the deck (App. Br. 12; Reply Br. 4). That is, the pulses do not encode imaging data or a reference to imaging data as claimed. Additionally, Appellants contend, "even if Faith's magnetic stripe could be interpreted to include sub-patterns, then each such sub-pattern is the portion of the magnetic stripe that is formed on an individual card" and not a subset of cards (App. Br. 12). That is, Faith teaches forming a sub-pattern on a single sheet (a position identification number); whereas Appellants' claimed invention teaches forming a sub-pattern on a different subset of sheets in the media stack and encoding imaging data or a reference associated with the imaging data for the subset of sheets.

Faith does not disclose, either expressly or inherently, each limitation of Appellants' independent claims 1, 2, 6, and 9, and claims 2 and 11 that depend therefrom. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). Thus, Faith does not anticipate these claims.

With respect to the obviousness rejection of claims 3-7, 9, 10, 12-16, 19-23, and 25-27 over Biegelsen and Faith, the Examiner again asserts the recited "pattern" is intended use. The Examiner further find Biegelsen contains a "stack of sheets, where one side of that stack contains an overall

pattern” (Ans.13). Appellants assert Biegelsen’s pattern is not a sub-pattern; rather the pattern on each sheet is unique to that sheet. Thus, Appellants argue the pattern identifies only the characteristics of an individual sheet and does not teach or suggest, alone or in combination with Faith, control logic communicating with a sensor to decipher the imaging data from the sub-patterns for each subset of sheets in the media stack, as claimed (App. Br. 16; Reply Br. 7-8). We agree. For these reasons, and those set forth above, the combination of Biegelsen and Faith does not render obvious claims 3-7, 9, 10, 12-16, 19-23, and 25-27.

CONCLUSION

The Examiner erred in rejecting claims 1, 2, 6, 8, 9, 11, and 18 under 35 U.S.C. § 102(b) and claims 3-7, 9, 10, 12-16, 19-23, and 25-27 under 35 U.S.C. § 103(a).

DECISION

The Examiner’s decision rejecting claims 1-16, 19-23, and 25-27 is reversed.

Appeal 2009-005366
Application 10/829,438

REVERSED

ELD

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